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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,042	02/26/2004	Pierre Lucien Cote	4320-556	2918
1059	7590	08/31/2006	EXAMINER	
BERESKIN AND PARR 40 KING STREET WEST BOX 401 TORONTO, ON M5H 3Y2 CANADA			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1723	
DATE MAILED: 08/31/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/786,042

Applicant(s)

COTE ET AL.

Examiner

Krishnan S. Menon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 17-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claims 1-7 and 17-28 are pending as amended 8/16/06.

#### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on 12/11/03. Certified copy of the priority document was received on 8/17/06.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-7, 20 and 22, are rejected under 35 U.S.C. 102(b) as being anticipated by Konno et al (US 4,002,567).

Claims 1-7: Konno teaches a unitary shell (8) for a header for a water treatment module (figure 1) having a recess (at 13) which receives filtration membrane (1), a protruding member (6) extending from an inner surface to the interior of the recess, injection duct inside (5) with inlet open to the outside (14) and outlet disposed within the

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interior of the recess (at 5). The lower end of the protruding member which forms part of the duct (5) is fixed to the shell (8) The injection duct extends through the length of protruding member (6), has the axial passage (5) and radial passage (holes on (6)) providing two or more discharge outlets, the protruding member passes through the permeate cavity (13), and the discharge outlet is located at an area in the shell. The outlet (gap at 5) is within the potting block.

The limitation “for injecting resin ...” is intended use. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)

The limitation “adapted to contain a block of potting material ...” is functional language. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard

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Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)

Claims 20 and 22: the recess has a block of resin, at least one opening (at 5) of the protruding member is open into the block of resin, and there are grooves on (6: threads) embedded in the block of resin.

2. Claims 1-7, 17-20 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Vossenkaul et al (US 2004/0035779).

Vossenkaul teaches a shell for a water treatment module comprising a plurality of needles with internal duct having inlet on the outside and outlets more or less axially located (see 1,8,11,16 of figure 1 and 2). The discharge outlets are located in the shell. The limitation "adapted to contain a block of potting ..." is functional language as shown in paragraph 1 above. "For injecting resin..." is intended use. The outlet of the protruding member is within the block of resin, since it protrudes through the resin. The office gives the broadest reasonable interpretation of the claim (During examination, the claims must be interpreted as broadly as their terms reasonably allow. In re American Academy of Science Tech Center, \*\*>367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)< (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation. If the end/outlet of the needle is completely within the resin and covered by the resin, it would not be an outlet anymore). Plurality of protruding members – figure 2.

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Claims 17-19: plurality of injections ducts, channel shape, and outlets at different spacing from the base – see figure 2 and 7. Each duct has several outlets which meet claim 19.

3. Claims 1-7, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Bikson et al (US 2002/0162455).

Bikson teaches a unitary shell having potted resin inside holding hollow fiber membranes (see figures 2,4, 5), protruding member (the tube extension at 206 into the potted resin), injection duct (the tube 110) which extends from the outside to the resin on the other end, it is partially filled with resin on the other end, the outlet is radial (holes 222), both the protruding member and the duct end inside the resin, the protruding member passes through a cavity; adapted to carry permeate, adapted to contain a block of resin, etc are functional language; for injecting resin is intended use.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vossenkaul as applied to claim 20 above, and further in view of Mahendran et al (US 6,042,677).

Claims differ from the teaching of Vossenkaul in the cushioning material.

Mahendran teaches having a layer of cushioning material on top of the resin layer – see column 3 lines 49-62. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Mahendran in the teaching of Vossenkaul to protect the hollow fibers from stresses as taught by Mahendran.

Regarding the second protruding members, Vossenkaul teaches plurality of the protruding members, see figure 2 or 7. Since the protruding members of Vossenkaul have outlets at different heights, they would read on to the first and second protruding members.

### ***Response to Arguments***

Applicant's arguments filed 8/16/06 have been fully considered but they are not persuasive. Applicant has not provided any specific arguments regarding patentability other than simply restating the claim limitations, a response to which is given in the rejection.

### ***Interview Summary***

In an examiner-initiated interview, a suggestion was made to amend the claims by combining claims 2,21 and 22, and canceling claims 1-7 and 17-19, to make the application in condition for allowance. However, the applicant requested an office action instead. Combination of claims 20-22 would be allowable over the prior arts because the resulting structure would provide support to the resin layer as described in applicant's specification paragraph 37. Vossenkaul figure 2 also has similar structure that would inherently provide such support; however, Vossenkaul does not teach the grooves on the protruding members which are embedded in the resin.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Krishnan S Menon  
Examiner  
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